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EXAMINER

CHOW, MING

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 10/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/843,137

Applicant(s)

HASEGAWA, NOZOMU

Examiner

Ming Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Objections***

1. Claim 4 is objected to because of the following informalities: The phrase “without establishing a voice or data channel with the message storage system” is repeated unnecessarily in the claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “different services” is not clearly defined.
3. Claims 6, 14, 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase “mailbox information” is not clearly defined.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 8, 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The phrase “updating the message service information ... by the message storage system” of claim 1 is not disclosed by the specification. On [0027] page 27 of the specification discloses “The HRR is updated responsive to available information relating to subscriber messages in the message storage systems”. The specification does not disclose the HRR (the claimed message service information) is updated by the message storage system.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1-3 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Brilla et al (US-PAT-NO: 6,389,276).

For claims 1 and 16, regarding receiving in the portable wireless telephone message service information from a resource database via a data channel between the portable wireless telephone and the resource database, Brilla et al teach on column 7 line 57 the message platform is integrated with the voice mail platform in a voice mail system capable of supplying a notification message to the wireless telephone station. The “message platform” of Brilla et al is the claimed “resource database”. The “notification message” of Brilla et al is the claimed “message service information”. Brilla et al also teach on column 9 line 1 the message platform outputs a notification message to the SMS. Brilla et al further teach on column 11 line 25 “sends the SMS command on a wireless signaling channel, or data channel, to the appropriate cell site. Regarding processing a message responsive to the message service information via a data channel between the portable wireless telephone and the message storage system according to the message service

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information, Brilla et al teach on column 16 line 64 the transmission of the command to a wireless telephone enables the voicemail/mobile subscriber to instantly access the stored voicemail message from the mobile telephone. The “access” of Brilla et al is the claimed “processing”. The “voice mail message” of Brilla et al is the claimed “a message”. Regarding updating the message service information in the resource database by the message storage system according to the processing via a data channel between the resource database and the message storage system, Brilla et al teach on column 14 line 49 monitors the message waiting signaling line to determine the storage of a new voicemail message for the voicemail subscriber. It is inherent that the message service information must be updated when a new voicemail message is detected.

Regarding claim 2, Brilla et al teach on column 7 line 57 “the message platform is integrated with the voice mail platform in a voice mail system capable of supplying a notification message to the wireless telephone station”. The “notification message” of Brilla et al is the claimed “subscriber mailbox information”.

Regarding claim 3, Brilla et al teach on ABSTRACT “notification of new voicemail messages”.

6. Claims 7, 11, 15, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Bowater et al (US-PAT-NO: 6,282,269).

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Regarding claim 7, Bowater et al teach on column 3 line 29 voice message can be retrieved by the second user either using an Internet telephone over the Internet. The "Internet" of Bowater et al is the claimed "data channel".

For claims 11, 15 and 19, regarding message storage systems storing voice messages, it is inherent that Bowater's system must have message storage systems storing voice messages.

Regarding a portable wireless telephone comprising a processor to control processing of a voice message on the message storage systems using a data channel with the message storage systems, it is also inherent that Bowater's system must comprise a processor to control processing of a voice message on the message storage systems.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-6 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Brilla et al, and in view of Sashihara (US-PAT-NO: 6,434,405).

For claims 4 and 7, regarding creating a resource database storing message service information,

Brilla et al teach on column 7 line 57 the message platform is integrated with the voice mail

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platform in a voice mail system capable of supplying a notification message to the wireless telephone station. The “message platform” of Brilla et al is the claimed “resource database”. The “notification message” of Brilla et al is the claimed “message service information”. It is inherent that the message platform (the claimed resource database) must be created. Regarding receiving in the portable wireless telephone message service information from a resource database via a data channel between the portable wireless telephone and the resource database, Brilla et al teach on column 7 line 57 the message platform is integrated with the voice mail platform in a voice mail system capable of supplying a notification message to the wireless telephone station. The “message platform” of Brilla et al is the claimed “resource database”. The “notification message” of Brilla et al is the claimed “message service information”. Brilla et al also teach on column 9 line 1 the message platform outputs a notification message to the SMS. Brilla et al further teach on column 11 line 25 “sends the SMS command on a wireless signaling channel, or data channel, to the appropriate cell site. Brilla et al failed to teach storing a message in the portable wireless telephone without establishing a voice or data channel with the message storage system.

However, Sashihara teaches on column 1 line 62 the above transmitting and receiving card may comprise: a memory for storing e-mail data and setting information. The “e-mail data” of Sashihara is the claimed “a message”. It is inherent that the e-mail data of Sashihara’s system is stored without establishing a voice or data channel with the message storage system. Regarding processing a message responsive to the message service information via a data channel between the portable wireless telephone and the message storage system according to the message service information, Brilla et al teach on column 16 line 64 the transmission of the command to a wireless telephone enables the voicemail/mobile subscriber to instantly access the stored



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voicemail message from the mobile telephone. The “access” of Brilla et al is the claimed “processing”. The “voice mail message” of Brilla et al is the claimed “a message”. Regarding updating the message service information in the resource database by the message storage system according to the processing via a data channel between the resource database and the message storage system, Brilla et al teach on column 14 line 49 monitors the message waiting signaling line to determine the storage of a new voicemail message for the voicemail subscriber. It is inherent that the message service information must be updated when a new voicemail message is detected. It would have been obvious to one skilled at the time the invention was made to modify Brilla et al to have the storing a message in the portable wireless telephone without establishing a voice or data channel with the message storage system as taught by Sashihara such that the modified system of Brilla et al would be able to support the storing a message without establishing a voice or data channel to the system users.

Regarding claim 5, Brilla et al teaches on column 9 line 61 the SMS may receive the notification message from numerous sources in addition to the e-mail message via the Internet. The “numerous sources” of Brilla et al reads on the claimed “different services”. It is inherent that the message platform of Brilla’s system must associate with the message storage systems for sending notification messages.

Regarding claims 6 and 18, Brilla et al teach on column 7 line 57 the message platform is integrated with the voice mail platform in a voice mail system capable of supplying a notification message to the wireless telephone station. The “notification message” of Brilla et al is the

claimed “message service information”. It is inherent that the “notification message” of Brilla’s system must comprise the claimed “location data (mailbox) of the message storage system and mailbox information (new message notification)”.

8. Claims 8-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bowater et al, and in view of Sashihara (US-PAT-NO: 6,434,405).

For claims 8, 12, and 13, Bowater et al failed to teach recording a message for a recipient subscriber in a portable wireless telephone without establishing a voice or data channel with the message storage system. However, Sashihara teaches on column 1 line 62 the above transmitting and receiving card may comprise: a memory for storing e-mail data and setting information. The “storing e-mail data” of Sashihara is the claimed “recording a message”. It is inherent that e-mail data of Sashihara’s system is stored without establishing a voice or data channel with the message storage system. Regarding querying address of a recipient-subscriber message storage system from a resource database via a data channel between the portable wireless telephone and the resource database, Bowater et al teach on column 4 line 39 receiving a voice message over the Internet. It is inherent that the (IP) address of the message storage system must be queried in order to retrieve the messages. Regarding transmitting the message to the recipient-subscriber message storage system via a data channel between the portable wireless telephone and the recipient-subscriber message storage system, it is inherent that the message of Bowater’s system must be transmitted to the message storage system via a data channel. Regarding storing the transmitted message in a mailbox for the recipient subscriber in the recipient-subscriber message storage system, Bowater et al teach on column 3 line 38 any voice mail stored in the voice mail

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system can be immediately available for retrieval by the mailbox owner. Regarding updating message service information of the recipient subscriber in the resource database by the recipient-subscriber message storage system according to the storing in the mailbox via a data channel between the resource database and the message storage system, it is inherent that Bowater's system must update the message service information (number of new messages must be updated when new messages are stored). Regarding alerting automatically a recipient-subscriber portable wireless telephone with the message service information by the resource database via a data channel between the resource database and the portable wireless telephone, Bowater et al teach on column 12 line 43 "send an email notification". The "notification" of Bowater et al is the claimed "alerting". Regarding establishing a data channel between the recipient-subscriber portable wireless telephone and the recipient-subscriber message storage system, it is inherent that a data channel (Internet) of Bowater's system must be established. Regarding processing the message in the recipient-subscriber portable wireless telephone via the data channel between the recipient-subscriber portable wireless telephone and the recipient-subscriber message storage system, it is inherent that Bowater's system must process the message via the data channel. Regarding updating the message service information of the recipient subscriber in the resource database by the recipient-subscriber message storage system according to the processing in the recipient-subscriber portable wireless telephone via a data channel between the resource database and the message storage system, it is inherent that Bowater's system must update the message service information (number of new/unread messages must be updated when new/unread messages are retrieved). It would have been obvious to one skilled at the time the invention was made to modify Bowater et al to have recording a message for a recipient subscriber in a portable

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wireless telephone without establishing a voice or data channel with the message storage system as taught by Sashihara such that the modified system of Bowater et al would be able to support the recording a message for a recipient subscriber in a portable wireless telephone without establishing a voice or data channel with the message storage system to the system users.

For claim 9, regarding receiving data packets corresponding to the message from the recipient-subscriber message storage system via the data channel, it is inherent that Bowater's system must receive data packets corresponding to the message from the message storage system via the data channel. Regarding presenting the message to the recipient subscriber on the recipient-subscriber portable wireless telephone, it is also inherent that Bowater's system must present the message to the recipient on the wireless telephone.

For claim 10, regarding transmitting and receiving data units comprising data packets corresponding the message, identification information of the message, total number of the data packets information and data packet sequence number information, it is inherent (for data communication) that Bowater's system must transmit and receive data units comprising data packets corresponding the message, identification information of the message, total number of the data packets information and data packet sequence number information. Regarding determining whether to retransmit data packets, it is inherent (error correction for data communication) Bowater's system must determine whether to retransmit data packets. Regarding retransmitting data packets responsive to the determining using the identification information, the total number of the data packets and the data packet sequence number

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information, it is inherent (error correction for data communication) the Bowater's system must retransmit data packets responsive to the determining (of error communication) using the identification information, the total number of the data packets and the data packet sequence number information.

Regarding claim 14, it is inherent that message service information of Bowater's system must comprise location data of the message storage system (IP address of the message storage system) and subscriber mailbox information (in order for retrieving the messages via Internet).

### *Conclusion*

9. The prior art made of record and not replied upon is considered pertinent to applicant's disclosure.

- Shaffer et al (US-PAT-NO: 6,434,222) teach apparatus and method for automated multi-media messaging system information updating.

10. Any inquiry concerning this application and office action should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or

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proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

**Or faxed to TC2600's Customer Service FAX Number 703-872-9314.**

Patent Examiner

Art Unit 2645

Ming Chow



FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

